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Attorney Docket No. PD-980142
Customer No. 020991

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	: Arsenault et al.) I hereby certify that this paper
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Title	: A System and) Commissioner of Patents, P.O.
	Method for) Box 1450, Alexandria, VA 22313-
	Transmitting,) 1450 on this date:
	Receiving and)
	Displaying) Dated: <u>5/12/03</u>
	Advertisements)
Art Unit	: 3622) <u>Frankie Ho</u>
)
Examiner	: Jean D. Janvier) Frankie Ho

BRIEF ON APPEAL

Mail Stop Appeal Brief-Patents
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Sir:

Pursuant to the Notice of Appeal mailed on March 13, 2003 in connection with the above-referenced patent application, the applicants respectfully submit the instant Brief on Appeal in accordance with 37 C.F.R. 1.192.

I. Real Party In Interest

The above-referenced patent application has been assigned to Hughes Electronics Corporation, which is the real party in interest to this appeal. The

assignment has been recorded in the United States Patent and Trademark Office ("PTO") at Frame 0710 of Reel 010591.

II. Related Appeals and Interferences

There are no related appeals or interferences.

III. Status of the Claims

Currently, claims 18-47 are pending in this application. The pending claims are presented in Appendix A to this Brief. Claims 18-47 stand rejected. Therefore, claims 18-47 form the subject matter of this appeal.

By way of background, this application was filed on January 27, 2000 with claims 1-40 and claims priority to U.S. Provisional Application No. 60/126,927, filed on March 29, 1999.

The first Office action mailed June 11, 2002 (Paper No. 2), *inter alia*, rejected claims 1-40 under 35 U.S.C. § 102(e) as anticipated by Hite et al. (U.S. Patent No. 5,774,170, hereinafter "Hite"), which discloses a system for delivering targeted advertising to consumers using television signals. *See* Paper No. 2, pages 5-10. Contrary to the examiner's contention, Hite fails to disclose the use of advertisement objects and linked image objects.

The applicants filed a response to the first Office action on August 28, 2002 (Paper No. 3). The response canceled claims 1-17, amended claims 18,

23 and 24, and added claims 41-47. Each of the pending claims recited the use of advertisement objects and image objects linked to advertising objects. The applicants indicated that Hite fails to disclose advertisement objects or image objects, much less linkages between such objects as claimed in the instant application.

The examiner issued a final Office action on November 15, 2002 (Paper No. 4), rejecting claims 18-47 as anticipated by Hite. The anticipation rejection is based on the contention that Hite inherently discloses the use of advertisement objects and linked image objects. *See* Paper No. 4, pages 5, 8, 11 and 13. However, the examiner failed to provide either a basis in fact or a line of technical reasoning to reasonably support this contention.

The applicants filed a response to the final Office action on January 15, 2003 (Paper No. 5). In the response, the applicants indicated that advertisement objects and image objects linked to the advertising objects were completely missing from Hite. The applicants further indicated that advertisement objects and linked image objects are completely unnecessary to the operation of the system disclosed by Hite. In fact, the examiner's contention that Hite necessarily discloses (i.e., inherently discloses) advertisement objects and linked imaged objects is in conflict with the teachings of Hite. As a result, the applicants indicated that the examiner failed to provide proper legal basis for his contention that Hite inherently discloses the use of advertisement objects and linked image objects.

The examiner issued an advisory Office action on February 14, 2003 (Paper No. 6). The advisory action maintained the aforementioned anticipation rejection and related inherency arguments. Accordingly, claims 18-47 stand rejected under 35 U.S.C. § 102(e) and form the subject of this appeal.

IV. Status of the Amendments

A response to the final Office action dated November 15, 2002 was filed on January 15, 2003. In the advisory Office action dated February 14, 2003 (Paper No. 6), the examiner indicated that the applicants' response to the final Office action (Paper No. 5) would be entered upon filing a notice of appeal and an appeal brief. Thus, the applicants submit that the amendments made to claim 41 in the response to the final Office action (Paper No. 5) have been entered, thereby overcoming the rejection of claim 41 under 35 U.S.C. § 112, ¶ 2 noted on page 3 of the final Office action. No additional amendments are believed to be necessary.

V. Summary of the Invention

Although reference numerals and specification citations are inserted below in accordance with 37 C.F.R. 1.192(c), these reference numerals and specification citations are merely examples of where support may be found in the specification for the terms used in this section of the brief. There is no

intention to suggest that the terms of the claims are limited to the examples in the specification. As demonstrated by the reference numerals and specification citations below, the claims are fully supported by the specification as required by law. Nevertheless, it is improper to read limitations from the specification into the claims. Pointing out specification support for the claim terminology, as is done here to comply with 37 C.F.R. 1.192(c), does not limit the scope of the claims to those examples from which they derive support. Nor does this exercise provide a mechanism for circumventing the law precluding reading limitations into the claims from the specification. In sum, the reference numerals and specification citations are not to be construed as claim limitations nor are they to be used in any way to limit the scope of the claims.

Independent claim 18 recites a digital advertisement system for use in receiving, processing, and displaying digital advertisement information having a processor and a memory communicatively coupled to the processor. *See* page 9, line 22 to page 10, line 5. The system includes a first software routine stored on the memory and adapted to be executed by the processor to receive advertising objects and image objects linked to the advertising objects from a transmitted data stream. *See* page 11, line 15 to page 12, line 6. The system also includes a second software routine stored on the memory and adapted to be executed by the processor to select a first group of advertising objects from the received advertising objects and image objects based on a local condition. *See* page 12, lines 7-16 and page 27, line 18 to page 28, line 29. The system

also includes a third software routine stored on the memory and adapted to be executed by the processor to sequentially display the first group of advertising objects using ones of the image objects linked to the first group of advertising objects. *See* page 28, line 30 to page 29, line 8.

Independent claim 24 recites a method of receiving advertisements for use in a receiver station that receives a data stream containing advertising objects and image objects linked to the advertising objects. *See* page 25, line 30 to page 26, line 5. The method includes selecting a received advertising object and its linked image objects from the transmitted data stream. *See* page 26, lines 5-17. The method also includes determining if the received advertising object and its linked image objects are compatible with the receiver station based on one or more data elements within the received advertising object and the linked image objects. *See* page 26, lines 18-19.

Independent claim 35 recites a method of displaying advertisements for use in a receiving station having a user interface. *See* FIG. 2. The method includes generating a first ordered list associated with a first advertisement display position of the user interface wherein the first ordered list contains a prioritized sequence of advertising objects. *See* page 29, lines 9-14. The method also includes sequentially displaying advertisements in the first advertisement display position of the user interface based on the first ordered list. *See* page 29, lines 14-17.

Independent claim 41 recites a system for use in generating digital advertisements having a processor and a computer readable medium coupled

to the processor. *See* page 9, line 22 to page 10, line 5. The system includes software stored on the computer readable medium and adapted to be executed by the processor to generate a plurality of advertisement objects. Each advertisement object includes data elements associated with scheduling and display of one of the digital advertisements. In addition, the system generates an identifier object having data elements identifying ones of the advertisement objects for use in selecting ones of the digital advertisements for display. *See* page 25, line 30 to page 29, line 25. The system also includes software stored on the computer readable medium and adapted to be executed by the processor to link image objects containing image information associated with digital advertisements to the advertisement objects. *See* page 11, line 15 to page 12, line 6.

VI. Issue on Appeal

The primary issue on appeal is whether claims 18-47 are patentable under 35 U.S.C. § 102 over Hite et al., U.S. Patent No. 5,774,170 (“Hite”). In particular, the issue presented on appeal is whether Hite inherently discloses the use of advertisement objects and linked image objects as recited in pending claims 18-47.

VII. Grouping of Claims

Claims 18-47 stand or fall together.

VIII. Argument

The examiner rejected claims 18-47 as anticipated by Hite. The examiner argued incorrectly that several features recited in claims 18-47 not expressly disclosed by Hite are instead inherently disclosed by Hite. As set forth in detail below, the applicants submit that the examiner's rejection of claims 18-47 is legally and factually flawed and should be reversed.

To rely upon the principle of inherency for anticipation of a claim, "the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *See Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). That is, inherency "may not be established by probabilities or possibilities." *See In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

In this case, the examiner has failed to provide either a basis in fact or a line of technical reasoning that reasonably supports the contention that Hite inherently discloses advertising objects and linked image objects.

A. The Examiner's Factual Basis, If Any, Is Erroneous

The examiner's factual basis, if any, is erroneous because he has misconstrued limitations of the pending claims. In particular, in the final Office action and the advisory action, the examiner erroneously stated, "The displayed advertisements comprising text and/or audio and/or video (image

objects or graphical representation) formats as inherently practiced in the television industry and known to those skilled in the art.” *See* Paper No. 4, page 5, and Paper No. 6, page 2.

Under the examiner’s definition, the term “object” as used in the terms “advertising object” and “image object” recited in claims 18-47, are video images, shapes or the like that are visually perceived by a human. In other words, it appears that the examiner has interpreted the term “object” to mean a text and/or graphical representation that form a part of a video image.

The examiner’s apparent definition of “object” completely ignores the context within which the claim terms “advertising object” and “image object” are used in the instant application. Moreover, it appears that the examiner has failed to interpret the terms of claims 18-47 in light of the specification, as is always required. *See U.S. v. Adams*, 178 USPQ 479, 482 (1966); *Markman v. Westview Instruments, Inc.*, 34 USPQ2d 1321, 1329-30 (Fed. Cir. 1995) (in banc), *aff’d* 38 USPQ2d 1761 (1996); *In re Dean*, 130 USPQ 107, 110 (CCPA 1961).

In particular, as clearly set forth in the instant application, advertising objects and image objects are digital data structures composed of characterizing data elements, some of which may be used to link to advertising objects and image objects. *See* Appendix B; and page 13, line 20 to page 19, line 15. The instant application states that each advertising object and image object includes one or more data elements that identify and characterize the object to schedule and to display an advertisement. *See* Appendix A;

Appendix B; page 8, lines 4-5; page 13, line 20 to page 19, line 15; and page 19, line 25 to page 23, line 25.

Advertising objects may be linked to other digital objects such as a Hypertext Transfer Protocol (HTTP) object, which is a particular type of image object. For example, the instant application states that an advertising object may include the data element "HTTP_object_id," which identifies an HTTP object that is linked to the advertising object. *See* Appendix B; and page 14, lines 21-23. As another example, an advertising object may include the data element "display_position," which identifies the physical display location for the advertising object (e.g., upper portion, middle portion, and/or lower portion within a program guide). *See* Appendix B; page 15, lines 14-22; and page 28, lines 10-24.

Although certain example objects have been described above, it should be noted that such objects are merely illustrative and should not be considered as limiting. Accordingly, the scope of coverage of the instant application is not limited thereto. In fact, it has been contemplated by the applicants that advertising objects and image objects could be embodied as other digital data structures.

Thus, when viewed in light of the specification as is required under the law, the claim terms "advertising object" and "image object" clearly refer to particular types of digital data structures (some examples of which are provided in the specification) and not, as the examiner appears to be suggesting, to graphical representations, text or other portions of a visually

perceptible video image. While the advertising objects and image objects claimed in the instant application can be used to generate perceptible video images that does not mean that the terms “advertising object” and “image object” are to be construed as such. To the contrary, when construed in light of the specification, the terms “advertising object” and “image object” clearly refer to digital data structures that may be linked to one another and that may be used to generate video images.

To the extent the examiner is arguing that the digital data structures to which the terms “advertising object” and “image object” refer are formats inherently practiced in the television industry, the applicants submit that such an argument is provided without any factual basis. By nature, an industry standard is generally well known to those of ordinary skill in the art to which the standard relates. Further, documentation and other printed matter relating to the standard is virtually always widely proliferated, and thus, easy to obtain.

In this case, the applicants are unaware of any digital television industry standard like that referred to by the examiner. Moreover, the examiner has failed to provide even a shred of objective evidence that such a standard exists. The examiner cannot merely assert that such a standard exists and then require the applicants to prove that such a standard does not exist. In the event that the original assertion has no factual basis, the applicants’ task to prove the negative becomes an impossible one.

In sum, instead of construing the terms “advertising object” and “image object” as clearly set forth in the instant application, the examiner has

erroneously construed the terms “advertising object” and “image object” as graphical representations or graphical images viewable on a television or a monitor. *See* Paper No. 6, page 2. Contrary to the examiner’s understanding, advertising objects and image objects are not visually perceptible graphical representations or graphical images of an advertisement but, rather, are digital data structures that may be used to generate visually perceptible advertisements. To the extent that the examiner is construing the terms “advertising object” and “image object” in this manner, he has failed to read these terms in light of the specification as required by law and, thus, has taken the terms “advertising object” and “image object” out of the context of the instant application. To the extent that the examiner is asserting that the terms “advertising object” and “image object” are part of some well-known digital television industry standard, he has failed to provide even a shred of objective evidence that such a standard exists. In any case, the examiner’s assertion that Hite inherently discloses advertising objects and linked image objects as recited in claims 18-47 is provided without any valid factual basis.

B. The Examiner’s Line of Technical Reasoning, If Any, Is Flawed

Independent claims 18, 24, 35, and 41, and claims dependent thereon, recite the use linkages between advertising objects and image objects. *See* Appendix A. Hite does not inherently disclose the use of such linkages, nor would it be an obvious design choice to modify the system taught by Hite to include such linkages.

The examiner appears to be arguing that Hite either inherently discloses linkages between advertising objects and image objects or that it would be an obvious matter of design choice to modify the system taught by Hite to include such linkages. However, as set forth above, Hite completely fails to disclose, either expressly or inherently, advertising objects and image objects as recited in the pending claims, much less linkages therebetween. Furthermore, the examiner has not provided any factual basis or cogent line of technical reasoning to support the position that such linkages are necessarily part of the system taught by Hite.

To the contrary, the examiner's argument appears to admit that linkages between advertising objects and image objects are absent from the system taught by Hite. Instead, the examiner appears to be arguing that such linkages could be introduced into the system taught by Hite as an obvious design choice because such linkages would not have a direct impact on the system taught by Hite. *See, e.g., In re Dembiczak*, 50 USPQ2d 1614, 1635-36 (Fed. Cir. 1999); *In re Gal*, 25 USPQ2d 1076, 1083-85 (Fed. Cir. 1992).

The examiner's line of technical reasoning in this case is seriously flawed. As clearly set forth in the instant application, advertising objects may be linked to one or more HTTP objects, which in turn, may include image and textual data that is to be displayed in connection with the advertising objects. *See* page 19, lines 16-18. Linking image information or other objects to advertising objects provides a flexible and efficient method and/or system of transmitting, receiving, storing, and displaying video-based advertisements

because image information does not have to be separately embedded within each of the advertising objects. As a result, image information used in more than one advertisement does not have to be duplicated. *See* page 12, lines 2-6; and page 19, lines 20-22. Thus, contrary to the examiner's contention set forth in the advisory action, linking an advertising object to one or more image objects directly and dramatically impacts the functionality of digital advertisement transmission system because image information can, for example, be transmitted once and used with multiple advertisements. *See* Paper No. 6, page 2.

As a final matter, the applicants note that the examiner appears to support his contention that it would be an obvious design choice to modify Hite to include linkages between advertising objects and image objects by pointing out that linkages take place in the background and are transparent to a viewer of an advertisement. Whether linkages are transparent to a viewer or not is wholly irrelevant to the matter at hand, which is whether the use of linkages between advertising objects and image objects in the system taught by Hite is an obvious matter of design choice.

By definition, all digital video transmission formats, processing schemes, and the like are transparent to a viewer. Following the examiner's apparent line of reasoning in this instance would result in grouping all digital transmission and/or processing techniques together as obvious substitutes or design choices. However, such a position ignores the fact that new digital video transmission formats, processing schemes and the like may be

patentable, regardless of whether a viewer sees them or perceives the effects thereof.

IX. Conclusion

In view of the foregoing, it is respectfully submitted that the rejections of claims 18-47 are based on legal and factual errors and that all of the pending claims should be allowed.

Respectfully submitted,

Dated: 5/12/03

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APPENDIX A

18. A digital advertisement system for use in receiving, processing and displaying digital advertisement information, the digital advertisement system comprising:

a processor;

a memory communicatively coupled to the processor;

a first software routine stored on the memory and adapted to be executed by the processor to receive advertising objects and image objects linked to the advertising objects from a transmitted data stream;

a second software routine stored on the memory and adapted to be executed by the processor to select a first group of advertising objects from the received advertising objects and image objects based on a local condition; and

a third software routine stored on the memory and adapted to be executed by the processor to sequentially display the first group of advertising objects using ones of the image objects linked to the first group of advertising objects.

19. The system of claim 18, wherein the second software routine is further adapted to be executed by the processor to select the first group of advertising objects based on a user's preferences.

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20. The system of claim 18, wherein the second software routine is further adapted to be executed by the processor to select the first group of advertisement objects based on a geographic location.

21. The system of claim 18, wherein the second software routine is further adapted to be executed by the processor to select the first group of advertisement objects based on a user interface sophistication level.

22. The system of claim 18, wherein the second software routine is further adapted to be executed by the processor to select a second group of advertisement objects based on a local condition.

23. The system of claim 18, wherein the third software routine is further adapted to be executed by the processor to display the first group of advertisement objects based on an ordered list.

24. A method of receiving advertisements for use in a receiver station with a cache memory that receives a data stream containing advertising objects and image objects linked to the advertising objects, the method comprising the steps of:

selecting a received advertising object and its linked image objects
from the transmitted data stream;

determining if the received advertising object and its linked image
objects are compatible with the receiver station based on one or more data
elements within the received advertising object and the linked image objects;
and

discarding the received advertising object if it is not compatible with
the receiver station.

25. The method of claim 24, further comprising the steps of
determining if the received advertising object is a new version of a previously
cached advertising object and replacing the previously cached advertising
object with the received advertising object if the received advertising object is
a new version of the previously cached advertising object.

26. The method of claim 25, wherein step of determining if the
received advertising object is a new version of a previously cached advertising
object includes the step of comparing data elements associated with
advertising object version.

27. The method of claim 24, further comprising the steps of
comparing a priority of the received advertising object to a lowest priority

associated with a plurality of cached advertising objects and discarding the received advertising object if the priority of the received advertising object is less than or equal to the lowest priority associated with the plurality of cached advertising objects.

28. The method of claim 26, wherein step of comparing a priority of the received advertising object to a lowest priority associated with a plurality of cached advertising objects includes the step of comparing data elements associated with display priority.

29. The method of claim 24, further comprising the step of replacing one from a plurality of cached advertising objects having a lowest priority with the received advertising object if the priority of the received advertising object is greater than the lowest priority of the one from the plurality of the cached advertising objects.

30. The method of claim 24, further comprising the step of discarding expired advertising objects from the cached memory.

31. The method of claim 30, wherein the step of discarding expired advertising objects from the cache memory includes the step of comparing a

data element associated with advertising object expiration to a local time at the receiver station.

32. The method of claim 24, wherein step of selecting a received advertising object from the transmitted data stream includes the step of identifying a data element associated with advertising objects.

33. The method of claim 24, further comprising the steps of determining if the received advertising object is compatible with a user's preferences and discarding the received advertising object if it is not compatible with the user's preferences.

34. The method of claim 33, wherein step of determining if the received advertising object is compatible with a user's preferences includes the step of comparing one or more data elements associated with descriptors to the user's preferences.

35. A method of displaying advertisements for use in a receiving station having a user interface, the method comprising the steps of:

generating a first ordered list associated with a first advertisement display position of the user interface, wherein the first ordered list contains a prioritized sequence of advertising objects; and

sequentially displaying advertisements in the first advertisement display position of the user interface based on the first ordered list.

36. The method of claim 34, further comprising the steps of discarding expired advertising objects from the first ordered list and inserting new advertising objects into the first ordered list.

37. The method of claim 35, wherein the step of generating a first ordered list associated with a first advertisement display position of the user interface includes the step of moving one of a pair of consecutive advertising objects having the same priority to a second ordered list so that the one moved advertising object has a higher rank in the second ordered list.

38. The method of claim 35, wherein step of sequentially displaying advertisements in the first advertisement display position of the user interface using the first ordered list includes the steps of:

comparing the priority of an advertising object associated with a second advertisement display position that at least partially overlays the first

advertisement display position to an effective priority of the first
advertisement display position; and

displaying the advertising object associated with the second
advertisement display position based on the result of the comparison.

39. The method of claim 38, wherein the effective priority is based
on an average of underlying display position priorities.

40. The method of claim 38, wherein the step of displaying the
advertising object associated with the second advertisement display position
based on the result of the comparison includes the step of simultaneously
terminating the display of an underlying advertisement when an overlaying
advertisement is scheduled to appear.

41. A system for generating digital advertisements, the system
comprising:

a processor;

a computer readable medium coupled to the processor; and software
stored on the computer readable medium and adapted to be executed by the
processor to:

generate a plurality of advertisement objects, each of which includes data elements associated with scheduling and display of one of the digital advertisement;

generate an identifier object having data elements identifying ones of the advertisement objects for use in selecting ones of the digital advertisements for display; and

link image objects containing image information associated with the digital advertisements to the advertisement objects.

42. The system of claim 41, wherein the software is further adapted to link at least one of the image objects to one of the advertisements through another one of the image objects.

43. The system of claim 41, wherein each of the advertisement objects include a data element associated with one of a user preference, a geographic location, a user interface sophistication level, a location within a display unit, a display priority, and a display time.

44. The system of claim 41, wherein the image information includes one of video information, graphical information and textual information.

45. The system of claim 41, wherein the image object includes data associated with one of a version of the image information, a priority, a sophistication level and an image format.

46. The system of claim 41, wherein the image objects are based on a transport protocol.

47. The system of claim 41, wherein the identifier object is an update list object.



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APPENDIX B

Data Elements of Advertising Object (AO)	Purpose
Object_type	Indicates that the object is associated with an advertisement.
Object_version	Indicates version of the object.
Time_first_referenced	Indicates the time that the AO is first scheduled for display.
Object_id	Uniquely identifies the AO.
HTTP_object_id	Identifies the object_id for an HTTP object that is linked to the AO.
Tuning_HTTP_indicator	Indicates whether the AO contains a tuning_general_URL.
UTC_display_control	Indicates that the AO contains start and stop times.
Number_of_positions	Identifies the number of display positions allowed for the AO.
Display_position	Identifies the physical display location for the AO.
Display_priority	Identifies the relative display priority for the AO.
Ad_start_time	Identifies the schedule start time.
Ad_stop_time	Identifies the schedule stop time.
Ad_start_year	Indicates the year in which the advertisement is to begin display.
Ad_start_month	Indicates the month in which the advertisement is to begin display.
Ad_start_day	Indicates the day in which the advertisement is to begin display.
Ad_start_hour	Indicates the hour in which the advertisement is to begin display.
Ad_start_minute	Indicates the minute in which the advertisement is to begin display.
Ad_stop_minute	Indicates the minute in which the advertisement is to stop displaying.

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Data Elements of Advertising Object (AO)	Purpose
Ad_stop_hour	Indicates the hour in which the advertisement is to stop displaying.
Ad_stop_month	Indicates the month in which the advertisement is to stop displaying.
Ad_stop_day	Indicates the day in which the advertisement is to stop displaying.
Ad_stop_year	Indicates the year in which the advertisement is to stop displaying.
Ad_duration	Indicates the duration in seconds that the advertisement will be displayed.
Tuning_general_URL_length	Provides the total length in bytes of the tuning_general_URL.
Tuning_general_URL	Provides the bytes for the URL.
Descriptors_loop_length	Provides the total length in bytes of various "descriptor" data elements.
About_descriptor	Provides an advertisement description.
Category_descriptor	Provides the category classification for the advertisement.
Name_descriptor	Provides associations between name texts and their corresponding entries in a naming system.
Name_long_descriptor	Provides associations between name texts and their corresponding entries in a naming system.
Name_relational_descriptor	Provides one or more sets of related name texts within a naming system.